



#12/Response
6/10/03
Patent
Attorney's Docket No. 027650-930

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
)
Thorbjorn ANDERSSON et al.) Group Art Unit: 1772
)
Application No.: 09/856,702) Examiner: Catherine A. Simone
)
Filed: May 25, 2001) Confirmation No.: 2294
)
For: MULTILAYER STRUCTURE FOR)
PACKAGING AND PACKAGING)
CONTAINERS MANUFACTURED)
THEREFROM, AS WELL AS)
METHOD FOR MANUFACTURING)
OF THE MULTILAYER)
STRUCTURE)

RECEIVED
JUN 06 2003
TC 1700

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Official Action dated March 3, 2003, reconsideration of the subject application is respectfully requested in light of the comments which follows:

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-5, 9-14, 16, 29, 30, and 32-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,500,303 to Anderson (hereafter "*Anderson*") in view of U.S. Patent No. 5,405,667 to Heider (hereafter "*Heider*") on the grounds set forth in paragraph 2 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

According to MPEP §706.02(j), a proper rejection under §103 should set forth (a) the relevant teachings of the prior art relied upon, (b) the differences between the claim and the reference, (c) the proposed modification necessary to arrive at the claimed invention; (d) why one of ordinary skill in the art would have been motivated to make the proposed modification. The rejection based on the combination of *Anderson* and *Heider* is improper because the rejection is not established why one of ordinary skill in the art would have been motivated to make the proposed modification.

Anderson discloses a multilayer structure for packaging. As shown in Figure 11, the multilayer structure has in intermediate layer of an expanded polymer 110 between plies 20 and 30. The only material explicitly disclosed for the foamed layer 110 is polystyrene. The expanded polymer 110 discloses in *Anderson* thus only references an expanded polymer of one material, and does not disclose, teach or suggest an expandable polymer material comprising a first rigid component and a second ductile polymer component.

The Examiner relies upon the disclosure in *Heider*, specifically cellular layer 18 in Figure 2 and column 4, lines 46-54, for allegedly disclosing that it is old and well known in the analogous art to have an expanded polymer material comprising a first rigid component and a second ductile component producing a multi-layer structure for packaging. The portions of *Heider* relied upon by the Examiner disclose that a preferred material for the cellular layer 18 includes low density polyethylene, high density polyethylene, medium density polyethylene and blends thereof. See, column 4, lines 46-54.

Heider discloses attaching labels to a molded container by an in-mold labeling process and does not disclose producing a multi-layer structure for packaging. See, column

1, lines 59-64. The label is formed of a layered structure and may consist of three layers of which the intermediate layer is foamed. Alternatively, the label has two layers of which one is foamed. See column 3, lines 46-50. The intermediate foamed layer insulates the inner surface of the inner layer of the label, which is heated at molding, and also provides bulk or stiffness to the label without adding weight to the label. The thickness permits handling in the mechanism that is utilized to insert the label within the mold cavity. See column 3, lines 20-25.

In contrast to the label, the structure for packaging disclosed in *Heider* is a "plastic container" made by conventional flow molding techniques. See column 2, lines 20-25. The disclosure in *Heider* references the container as being a "plastic container" and does not disclose any further material composition of the packaging. Further, the label is applied to the plastic container and the arrangement of the label and the materials of the label do not constitute a structure for packaging, e.g., the plastic container is the structure for packaging.

Thus, one of ordinary skill in the art at the time of the invention considering the disclosure in *Heider* would, at best, have considered using the layered structure having an intermediate foamed layer only as a label structure applied to a structure for packaging and would not have considered the label structure itself as a structure for packaging. In other words, there is no motivation to apply the multilayer label attached to a surface of a plastic container disclosed in *Heider* to a structure for packaging as disclosed in *Anderson*. For at least this reason, the rejection should be withdrawn.

In addition, the *Heider* reference has quite a different purpose and solves quite a different problem as compared to a multilayer structure for packaging. For example, the stiffness required to place a label in a cavity in a mold is quite different from the stiffness required in a packaging bottle. These differences would not lead one of ordinary skill to apply the same structure recommended for such a label to a packaging laminate or a bottle for liquid packaging.

Further, the disclosure in *Heider* of polyethylenes such as low density polyethylene, medium density polyethylene, and high density polyethylene, or blends thereof, would not lead one of ordinary skill in the art to prefer blends over pure polyethylene qualities nor does the disclosure in *Heider* explain the reason for selecting a particular polyethylene. In contrast, applicants on page 7, line 28-page 8, line 11 explain that an expandable polymer layer having a first rigid component and a second ductile component provides improved mechanical characteristics.

For at least the above noted reasons, the rejection should be withdrawn.

The rejection over the combination of *Anderson* in view of *Heider* is also improper because it relies upon an incorrect application of the doctrine of inherency. For example, claims 10 and 33 have been rejected in the Official Action because the mixing ratio of the first, rigid polymer component to the second, ductile polymer component in the expanded polymer layer is "inherently between 1:3 and 3:1." However, in order for a claimed element to be "inherent" in a prior art reference, the claimed element or feature must necessarily result from the prior art. "Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it

would be so recognized by persons of ordinary skill." And, inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Continental Can Co., U.S.A. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

In order words, for the claimed mixing ratio of claims 10 and 33 to be inherent in the combination of *Anderson* and *Heider*, every multilayer polymer layer that could be used in the combination of references must have the claimed mixing ratio. It is not sufficient that a structure that meets the description set forth in the combination of *Anderson* and *Heider* may have the claimed mixing ratio. See, In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). ("The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.") There is no reason based on the teachings of *Anderson* and *Heider* that an expanded polymer layer must necessarily have the claimed mixing ratio. Accordingly, the claimed mixing ratio is not inherent and the rejection set forth by the Examiner is based on an incorrect understanding of the doctrine of inherency. Accordingly, the rejection must be withdrawn.

The rejection of claims 15, 17, 18, 20 and 21 under 35 U.S.C. §103(a) over *Anderson* in view of *Heider* and in further view of U.S. Patent No. 5,093,164 to Bower et al. (hereafter "*Bower et al.*") should be withdraw. The combination relied upon for the rejection of these claims is deficient for at least the same reasons as noted above with respect to the combination of *Anderson* in view of *Heider*. Specifically, *Anderson* in view of *Heider* has not established the *prima facie* case of obviousness of the independent claim. Accordingly, the dependent claims are allowable for at least the same reasons as noted

above. Further, the disclosure in *Bower et al.* does not address the deficiency previously discussed with respect to the combination of *Anderson* in view of *Heider*. Accordingly, applicants respectfully request withdrawal of this rejection.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____

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Date: June 3, 2003



1772

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AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- ☐ Applicant(s) request suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADDT'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$84.00 (1201) =	
If Amendment adds multiple dependent claims, add \$280.00 (1203)					
Total Amendment Fee					
If small entity status is claimed, subtract 50% of Total Amendment Fee					
TOTAL ADDITIONAL FEE DUE FOR THIS AMENDMENT					

☐ A claim fee in the amount of \$_____ is enclosed.

☐ Charge \$_____ to Deposit Account No. 02-4800.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: June 3, 2003

By:


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